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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,759	12/28/2000	Lawrence R. Biggs JR.	12665.46	9577

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EXAMINER

CHAN, WING F

ART UNIT PAPER NUMBER

2643

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,759

Applicant(s)

Biggs, Jr. et al

Examiner

Wing F. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 17, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 13 6) ☐ Other:

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1. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

2. Since the litigation related to this reissue application is terminated and final, action in this reissue application will NOT be stayed. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "central distribution box" and the "private switched network telephone system" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. Claims 1, 18-22, 24-27 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The terms "central distribution box" broadens the scope of the claims since the term box is broader than the term "computer". A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process

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which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

The term “central distribution box” is only found on col. 5, lines 18 of the patent specification but there is no description as to what constitutes the “central distribution box”, i.e. the specifics such as the circuitry, etc., therefore its scope can be any conceivable product or process.

Applicants in the response to the protest filed 5/1/02 have attempted to define what is meant by a “central distribution box” by alleging that “those skilled in the art would recognize that a central distribution box equates with the term “headend” or “central distribution point”, and is a commonly recognized term in the art.’

However, this is not found to be persuasive. As the evidence provided by applicants only defines what is meant by a “headend” or “central distribution point”, and applicants further allege that the “headend” equates a “central distribution point” but there is no evidence of any sort presented to link a “central distribution box” to a “headend” or “central distribution point”, much less equating a “central distribution box” to a “headend” or “central distribution point”. The mere allegations by applicants that the “central distribution box” is the same as a “headend” or “central distribution point” without any evidence are not persuasive and further applicants’ conclusion that the use of the term “box” is narrowing rather than broadening is also not persuasive. Therefore, the use of the term “box” is considered broadening of claims.

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5. Claims 23 is rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The terms “store-and-forward switch (SFS)” broadens the scope of the claim. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

As the MPEP 1412.03 states “A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims....A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement.

The specification discloses the SFS can be remotely located away from the amenity location through a switched network, and to replace the central distribution computer (CDC) of claim 2 with the SFS to form new reissue claim 23 is a broadening of claims. As argued by applicants in the prosecution of the original patent application the CDC is on-site, while the SFS need not be on-site, thus the replacement of CDC with SFS broadens the scope of the claims. As such the terms “store-and-forward switch (SFS)” as recited in new reissue claim 23 is considered a broadening claim since it allows the patent owner to sue any party for infringement who previously could not have been sued for infringement when a store-and-forward switch is connected to amenity device.

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6. Claim 23 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the new reissue claim 23, which is based on claim 2, the CDC is replaced with SFS to perform the same function that's originally performed by the CDC, this change constitutes recapture. As disclosed in the specification, the SFS can be remotely located away from the amenity location through a switched network, and to replace the central distribution computer (CDC) of claim 2 with the SFS to form new reissue claim 23 constitutes recapture. As argued by applicants during the prosecution of the original patent application the CDC is on-site and not connected to amenity location through the switched network, while the SFS need not be on-site and can be connected to amenity location through the switched network, thus the replacement of CDC with SFS constitutes recapture of subject matter surrendered during prosecution of the original patent.

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7. Claims 21 is rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The terms “private switched network telephone system” and “public switched network telephone system” broadens the scope of the claim. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

As the MPEP 1412.03 states “A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims....A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement.

By adding the terms public and private the scope of new reissue claim 21 as compared to patent claim 1 is broadened in that a central distribution box which is connected to the amenity device through a private switched network telephone system could not infringe claim 1 but could infringed on reissue claim 21. As such the addition of the terms “private” and “public” as recited in new reissue claim 21 is considered a broadening claim since it allows the patent owner to sue any party for infringement who previously could not have been sued for infringement.

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8. Claim 21 is rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

“private switched network” (claim 21, line 4).

The term “private switched network” is new matter. Throughout the specification the PBX (private branch exchange) and the switched network are disclosed as two separate entities, for example see Figs. 1, 2, and the two are not the same nor are the two interchangeable. In addition, the term “switched network” is an art accepted term to stand for PSTN--public switched telephone network, and such is found in Newton's Telecom Dictionary. And by all indications in the specification of the original patent, such as col. 10 line 67 to col. 11 line 4, the ‘switched network’ is a “public switched network” and not a private switched network as alleged by applicants. Thus, the term “private switched network” is new matter not supported by the specification.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 2-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification was determined by the Court of Appeals for the Federal Circuit as failing to satisfy the written description requirements with respect to the term “central distribution computer”, specifically pages 10-15 of the Federal Circuit Decision which are incorporated by reference herein. Although the Federal Circuit’s findings only invalidated claims 1 and 18 of the ‘448 patent as claims 1 and 18 were at issue during the court proceedings, nonetheless the Federal Circuit’s finding of the specification as failing to comply ‘with the written description requirement with regarding to the term “central distribution computer”” (page 15 of the decision) also holds true to the use of the term “central distribution computer” as is recited in the other claims.

In addition, the specification discloses the ‘store-and-forward switch 20, as will be described hereinbelow, basically comprises a device that can buffer a dialed phone number or call up pre-stored phone numbers, examine the dialed phone number and the associated data, such as authorization codes, and then forwards a call to a different number that was either dialed in or accessed from internal memory. Some features of the store-and-forward switch have been known with respect to autodialers. The store-and-forward switch 20 is operable to receive information from the access phone 10 through the PBX 12 in the form of credit card information. This credit card information is recognized by the store-and-forward switch 20 and then a validation routine processed to validate the card number against a database. After validation, the information that was transmitted to the store-and-forward switch 20 with the credit card number, typically in the form of an amenity

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identification number, is utilized to determine the selected amenity. A prestored authorization code associated with the selected amenity is then sent to the selected amenity through the switched network 22 and, upon acknowledgement, the access phone 10 is then connected to the amenity.” (col. 3 lines 17-42 of the patent). And in other passages throughout the specification, the function or purpose of the store-and-forward switch is receive credit card information, amenity information from the user and to validate the credit card information and return an authorization code associated with the selected amenity. Therefore, the specification clearly fails to provide an adequate written description of the “central distribution computer”, nor can the store-and-forward switch be viewed as a “central distribution box”, in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

11. Claims 1, 18-22, 24-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The term “central distribution box” is only found on col. 5, lines 18 of the patent specification but there is no other description through either words or figures as to what constitutes this “central distribution box”, i.e. the specifics such as the circuitry, etc. that would be inside the box, thus leaving this “central distribution box” as being undefined. There is no explanation or description as to how is the distribution function performed, what is encompassed by central, what’s

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in the box. There is no explanation as to how the "central distribution box" facilitate the offering of movies. Therefore, the specification clearly fails to provide an adequate written description of the "central distribution box" in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification is inadequately written to provide support for the limitation "said billing computer instructing said SFS to offer said movie at said amenity location". The specification discloses the 'store-and-forward switch 20 is operable to receive information from the access phone 10 through the PBX 12 in the form of credit card information. This credit card information is recognized by the store-and-forward switch 20 and then a validation routine processed to validate the card number against a database. After validation, the information that was transmitted to the store-and-forward switch 20 with the credit card number, typically in the form of an amenity identification number, is utilized to determine the selected amenity. A prestored authorization code associated with the selected amenity is then sent to the selected amenity through the switched network 22 and, upon acknowledgement, the access phone 10 is then connected to the amenity." (col. 3 lines 27-42 of the patent). And in other passages throughout the specification, the function or

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purpose of the store-and-forward switch is receive credit card information, amenity information from the user and to validate the credit card information and return an authorization code associated with the selected amenity. This is not the same as the limitation "said billing computer instructing said SFS to offer said movie at said amenity location" since the SFS never offers any movie at the amenity location. Therefore, the specification clearly fails to provide an adequate written description of the "said billing computer instructing said SFS to offer said movie at said amenity location" in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

13. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The addition of the term "private" to the switched network is new matter and the specification also fails to provide an adequate written description to support a "private switched network". Throughout the specification the PBX (private branch exchange) and the switched network are disclosed as two separate entities, for example see Figs. 1, 2, and the two are not the same nor are the two interchangeable. In addition, the term "switched network" is an art accepted term to stand for PSTN--public switched telephone network, and such is found in Newton's Telecom Dictionary. And by all indications in the specification of the original patent, such as col.

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10 line 67 to col. 11 line 4, the switched network is a "public switched network" and not a private switched network as alleged by applicants. Thus, the limitation a "private switched network" is new matter and the specification also fails to provide an adequate written description in support of a "private switched network".

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Theurer et al (US PAT. NO. 4,008,369 hereinafter Theurer).

Theurer discloses a method for a user to access pay per view offerings at an amenity location (e.g. hotel, motel, etc.) comprising providing a central distribution box (note elements 15-20 in central station 1 which provides the offerings to the telephone user) located within said facility (note Theurer Fig. 1, col. 6 lines 46-65 which clearly distinguishes outside telephone lines 27 from in-house or on-site telephone line 23), inter alia control and monitoring station 21 and printer 22 correlates to the claimed store-and-forward switch since as disclosed in applicants' specification the function of the store-and-forward switch is to receive, store amenity information and billing information and this function is provided by the control and monitoring station 21 and printer 22

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(note Theurer col. 6 line 66 to col. 13 line 3 for example), as to the billing, amenity information see Theurer Fig. 6, and responsive to the receiving and storing, control and monitoring station 21 instructs the central distribution box to offer a pay per view offering selected by the telephone user at the amenity location (hotel guest room).

16. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,323,448 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

17. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 for any facsimile communications (for Technology Center 2600 only).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is (703) 305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at 703-305-4708.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



WING F. CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

WFC